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OFFICE OF PETITIONS

In re Application of
Ream, et al.
Application No. 09/434,837
Filed: 4 November, 1999
Attorney Docket No. 245-53722

ON PETITION

This is a decision on the petition styled as "Petition for Withdrawal of Abandonment (37 C.F.R. §1.8(b))" (sic) and filed on 30 April and supplemented on 31 December, 2001. The petition is more appropriately treated as a request for the withdrawal of the holding of abandonment under the provisions of 37 C.F.R. §1.181.¹

NOTE: As indicated at Fn. 4, the basic filing fee was paid for a not-small entity.

Assignments recorded and checks for subsequent fees suggest that the entity is a small entity. However, while the Office accepts payment of the Basic Filing Fee in the exact amount for a small entity as a statement of such status, no other fee payments constitute such a statement.

Therefore, within one (1) month of the mailing of this decision
Petitioner must satisfy the requirements under 37 C.F.R. §1.27.²

¹ The regulations at 37 C.F.R. §1.181 provide, in pertinent part:

§1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. ***

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declaration (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed. ***

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings. ***

² The regulations at 37 C.F.R. §1.27 provide, in pertinent part:

§1.27 Definition of small entities and establishing status as a small entity to permit payment of small entity fees; when a determination of entitlement to small entity status and notification of loss of entitlement to small entity status are required; fraud on the Office.

(a) *Definition of small entities.* A small entity as used in this chapter means any party (person, small business concern, or nonprofit organization) under paragraphs (a)(1) through (a)(3) of this section.

(3) *Nonprofit Organization.* A nonprofit organization, as used in paragraph (c) of this section, means any nonprofit organization that:

(i) Has not assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or

The request to withdraw the holding of abandonment is GRANTED, and the petition under 37 C.F.R. §1.8(b)³ is DISMISSED as moot.

license, any rights in the invention to any person, concern, or organization which would not qualify as a person, small business concern, or a nonprofit organization, and

(ii) Is either:

(A) A university or other institution of higher education located in any country;

(b) *Establishment of small entity status permits payment of reduced fees.* A small entity, as defined in paragraph (a) of this section, who has properly asserted entitlement to small entity status pursuant to paragraph (c) of this section will be accorded small entity status by the Office in the particular application or patent in which entitlement to small entity status was asserted. Establishment of small entity status allows the payment of certain reduced patent fees pursuant to 35 U.S.C. 41(h).

(c) *Assertion of small entity status.* Any party (person, small business concern or nonprofit organization) should make a determination, pursuant to paragraph (f) of this section, of entitlement to be accorded small entity status based on the definitions set forth in paragraph (a) of this section, and must, in order to establish small entity status for the purpose of paying small entity fees, actually make an assertion of entitlement to small entity status, in the manner set forth in paragraphs (c)(1) or (c)(3) of this section, in the application or patent in which such small entity fees are to be paid.

(1) *Assertion by writing.* Small entity status may be established by a written assertion of entitlement to small entity status. A written assertion must:

(i) Be clearly identifiable;

(ii) Be signed (see paragraph (c)(2) of this section); and

(iii) Convey the concept of entitlement to small entity status, such as by stating that applicant is a small entity, or that small entity status is entitled to be asserted for the application or patent. While no specific words or wording are required to assert small entity status, the intent to assert small entity status must be clearly indicated in order to comply with the assertion requirement.

(2) *Parties who can sign and file the written assertion.* The written assertion can be signed by:

(i) One of the parties identified in § 1.33(b) (e.g., an attorney or agent registered with the Office), § 3.73(b) of this chapter notwithstanding, who can also file the written assertion;

(ii) At least one of the individuals identified as an inventor (even though a § 1.63 executed oath or declaration has not been submitted), notwithstanding § 1.33(b)(4), who can also file the written assertion pursuant to the exception under § 1.33(b) of this part; or

(iii) An assignee of an undivided part interest, notwithstanding §§ 1.33(b)(3) and 3.73(b) of this chapter, but the partial assignee cannot file the assertion without resort to a party identified under § 1.33(b) of this part.

(3) *Assertion by payment of the small entity basic filing or basic national fee.* The payment, by any party, of the exact amount of one of the small entity basic filing fees set forth in §§ 1.16(a), (f), (g), (h), or (k), or one of the small entity basic national fees set forth in §§ 1.492(a)(1), (a)(2), (a)(3), (a)(4), or (a)(5), will be treated as a written assertion of entitlement to small entity status even if the type of basic filing or basic national fee is inadvertently selected in error.

(i) If the Office accords small entity status based on payment of a small entity basic filing or basic national fee under paragraph (c)(3) of this section that is not applicable to that application, any balance of the small entity fee that is applicable to that application will be due along with the appropriate surcharge set forth in § 1.16(e), or § 1.16(l).

(ii) The payment of any small entity fee other than those set forth in paragraph (c)(3) of this section (whether in the exact fee amount or not) will not be treated as a written assertion of entitlement to small entity status and will not be sufficient to establish small entity status in an application or a patent.

(d) *When small entity fees can be paid.* Any fee, other than the small entity basic filing fees and the small entity national fees of paragraph (c)(3) of this section, can be paid in the small entity amount only if it is submitted with, or subsequent to, the submission of a written assertion of entitlement to small entity status, except when refunds are permitted by § 1.28(a).

(e) *Only one assertion required.*

(1) An assertion of small entity status need only be filed once in an application or patent. Small entity status, once established, remains in effect until changed pursuant to paragraph (g)(1) of this section. Where an assignment of rights or an obligation to assign rights to other parties who are small entities occurs subsequent to an assertion of small entity status, a second assertion is not required.

(2) Once small entity status is withdrawn pursuant to paragraph (g)(2) of this section, a new written assertion is required to again obtain small entity status.

(f) *Assertion requires a determination of entitlement to pay small entity fees.* Prior to submitting an assertion of entitlement to small entity status in an application, including a related, continuing, or reissue application, a determination of such entitlement should be made pursuant to the requirements of paragraph (a) of this section. It should be determined that all parties holding rights in the invention qualify for small entity status. The Office will generally not question any assertion of small entity status that is made in accordance with the requirements of this section, but note paragraph (h) of this section.

[47 Fed. Reg. 40139, Sept. 10, 1982, added effective Oct. 1, 1982; para. (c) added, 47 Fed. Reg. 43276, Sept. 30, 1982; paras. (b), (c), and (d), 49 Fed. Reg. 553, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Sept. 8, 2000]

³ The regulations at 37 C.F.R. §1.8(b) provide:

§ 1.8 Certificate of mailing or transmission.

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this

Review of the record indicates that:

- a Notice of Missing Parts (Filing Date Granted) was mailed on 2 December, 1999, and required that signed oaths or declarations (and fee)⁴ be filed;
- as reflected by a copy of the date-stamped (31 January, 2000) receipt card filed with the petition, on 31 January, 2000, Petitioner filed a response to the Notice of Missing Parts, including therein a copy of the Notice, two combined declaration/power of attorney forms (one signed by two inventors and the other signed by the remaining one inventor) a check for fees and authorization to charge a deposit account if necessary, and two assignment forms and fees;
- Office records indicate that those fees were "booked" at the small entity rate on 3 February, 2000;
- apparently the signed oath/declarations were separated from the file and those documents may have been forwarded to the Assignment Branch with other documents to be recorded;
- while a Notice of Incomplete Reply (Filing Date Granted) was mailed on 16 February, 2000, no Notice of Abandonment was mailed;⁵

Nonetheless, for reasons that are unclear, with or without a Notice of Abandonment, the application is coded in the Office database as being abandoned--and held so.

Accordingly, the Holding of Abandonment contained in the Office database is in error and is withdrawn. The petition fee is waived.⁶ In addition, the Notice of Incomplete Reply of 16 February, 2000, was mailed in error and is vacated.

section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

[41 Fed. Reg. 43721, Oct. 4, 1976; 43 Fed. Reg. 20461, May 11, 1978; para. (a). 47 Fed. Reg. 47381, Oct. 26, 1982, effective Oct. 26, 1982; para. (a), 48 Fed. Reg. 2708, Jan. 20, 1983; para. (a) 49 Fed. Reg. 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (a), 49 Fed. Reg. 5171, Feb. 6, 1985, effective Mar. 8, 1985; 52 Fed. Reg. 20046, May 28, 1987; subparas. (a)(2)(xiv)-(xvi), 54 Fed. Reg. 37588, Sept. 11, 1989, effective Nov. 16, 1989; revised, 58 Fed. Reg. 54494, Oct. 22, 1993, effective Nov. 22, 1993; para. (a) revised, 61 Fed. Reg. 56439, Nov. 1, 1996, effective Dec. 2, 1996; paras. (a)(2)(i)(A) & (b) revised; 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997]

⁴ The application was filed with fees for a not-small entity, however, the application clearly was assigned to an entity for which small entity status is appropriate, and subsequent fees were paid as though the applicant/assignee was a small entity.

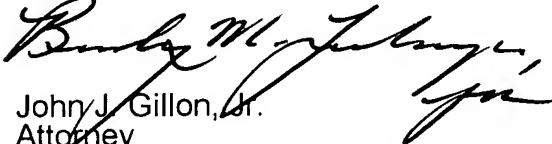
⁵ At that stage, it appears that the file was misplaced and could not be retrieved between the filing of the instant petition in April 2001 and the drafting of this decision eight months later.

⁶ No fee was charged upon the filing of this petition.

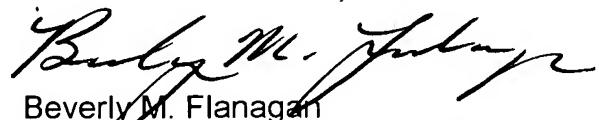
The additional copies of the oath or declaration provided with the instant petition have been separated from those materials and prominently placed in the file for review by OIPE and, in due course, the Examiner.

This application is being forwarded to OIPE for such processing as necessary before being assigned to a technology center for examination.

Telephone inquiries should be directed to John J. Gillon, Jr., Attorney, Office of Petitions, at (703) 305-9199.



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